

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Frank Semersky et al.

Application No.: 10/800,566

Confirmation No.: 9823

Filed: March 15, 2004

For: PASTEURIZABLE WIDE-MOUTH
CONTAINER

Art Unit: 3721

Examiner: Christopher R. Harmon

Atty. Docket No.: 29953-215594

Customer No. **26694**
PATENT TRADEMARK OFFICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop After Final
Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

Dear Sir;

In response to the Advisory Action of March 22, 2006, Applicants submit this Pre-Appeal Brief Request for Review. Applicants constructively petition for a one-month extension of time, and authorize the Office to charge the \$120 extension fee and the \$500 Notice of Appeal Fee to our Deposit Account No. 22-0261. The Office is further authorized to charge any additional fees or credit any overpayments to Deposit Account No. 22-0261

Rejection of Claims 3-21 under 35 U.S.C. § 103

The Office Action rejected present claims 3-21 as unpatentable over U.S. 5,887,739 to Prevot (Prevot) in view of U.S. 5,908,128 to Krishnakumar (Krishnakumar) for the reasons set forth in pages 5-6 of the Final Office Action of January 13, 2006 and in the subsequent Advisory Action of March 22, 2006. Applicants believe the rejection is improper because the Office Action fails to set forth a prima facie case for obviousness. (See Request for Reconsideration filed March 13, 2006, page 3, paragraphs 2

and 3.) First, there is no motivation to combine the references. (See Request for Reconsideration, page 3, paragraphs 3 and 4.) The Advisory Action states that both references are directed to increasing [top] load capability, but there is no such disclosure in Krishnakumar. Again, Krishnakumar is concerned with accommodating pressure changes that occur during pasteurization.

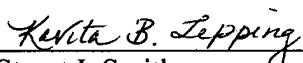
It is respectfully submitted that the Action is using Applicants' disclosure as the source of motivation for the combination, and that this use amounts to an impermissible hindsight bias. (See Request for Reconsideration, page 4, top paragraph.) Even if one of skill in the art were to combine the references, there is no reasonable expectation of success. (See Request for Reconsideration, page 4, second paragraph.) Additionally, due to the desire to minimize product weight, containers built for hot-fill (Prevot) due not have the needed bulk to withstand pasteurization (Krishnakumar).

Conclusion

The Office Action fails to satisfy a prima facie case for obviousness because the Action does not meet at least the first two requirements as set forth in the MPEP. In view of the above, it is respectfully submitted that independent claims 3-21 are patentable over the art of record. Reconsideration and allowance of the present application is respectfully requested.

Respectfully submitted,

May 10, 2006


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SIS/KBL 747352